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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kevin Embree

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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY

P.O. BOX 2938

MINNEAPOLIS, MN 55402

EXAMINER

CARTER, CANDICE D

ART UNIT

PAPER NUMBER

3629

NOTIFICATION DATE

DELIVERY MODE

06/15/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/822,894	<b>Applicant(s)</b> EMBREE, KEVIN	
	<b>Examiner</b> CANDICE D. CARTER	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/2/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is a First Action Non-Final on the merits after filing of an RCE. Claims 1, 11, 21 and 22 have been amended. Claims 10 and 20 have been cancelled. No new claims have been added. Therefore, Claims 1-9, 11-19, 21, and 22, as originally filed, are currently pending and have been considered below.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April, 2, 2009 has been entered.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**4. Claims 11-19 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 11-19 are directed towards a method to detect outlying behavior in a networked based marketplace comprising collecting information, storing information, computing information, comparing information, and detecting outlying behavior.

Examiner contends that a process must be (1) tied to another statutory class (such as a particular machine) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

An applicant may show that a process claim satisfies 35 U.S.C. § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent eligibility. See *Benson*, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. *In re Bilski*.

In the instant case, the method claim does is not tied to a machine and, as such, is not considered to be a statutory process.

Claim 21 invokes 112, 6<sup>th</sup> paragraph and appears to be directed to a system to detect outlying behavior in a network-based marketplace consisting, essentially, of software modules as claimed in claim 1. The term "module" is not recited as having corresponding structure in the specification and given its broadest reasonable interpretation can be construed as nothing more than program code. Therefore the claims are directed to nothing more than a program code per se and are non-statutory.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**6. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

Claims 1-9 describes the sellers but fails to fully describe the system of the invention. Therefore, the system as claimed is not described in such a way as to enable a person of ordinary skill in the pertinent art to make or use the invention as it is currently recited.

**7. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**8. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 17 recites the limitation “average seller”. It is unclear what Applicant considers to be an average seller. Examiner requests appropriate clarification.

### ***Claim Rejections - 35 USC § 102***

**9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 1-3, 5, 8, 11-13, 15, 18, and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Harding et al. (2005/0144052, hereinafter Harding).**

As per claim 1, Harding discloses “A computer implemented system to detect outlying behavior in a network-based marketplace, the computer implemented system including:

a processor and memory for executing modules of programming code (Fig. 1 discloses computer systems)

a collection module to collect attribute information for a first plurality of sellers that includes a first seller and to store the attribute information in a storage device” (Fig. 1 discloses a storage device for storing attribute information and ¶ 25 discloses collecting information about a seller's performance, where this information reflects the sellers attributes);

“a computing module to compute peer information associated with a second plurality of sellers, the second plurality of sellers comprising a subset of said first plurality of sellers, the peer information computed by combining together the attribute information for the second plurality of sellers” (¶ 29-31 discloses computing seller scores/ratings for the sellers, where the total group of sellers represents the first group of sellers and where a feedback rating of 1 or 2 denotes sellers with a negative rating and a rating of 5 denotes sellers with a positive rating; sellers with negative or positive

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ratings represent second groups of sellers; Examiner construes the second group to be a subset of the first group and ¶ 26 discloses computing statistics for the sellers);

“a comparison module to compare the peer information associated with the second plurality of sellers with attribute information for the first seller” (¶ 42 discloses comparing scores of the seller to a minimum seller score threshold to determine if sellers are recommended sellers or not, where the comparison is done against other sellers that do or do not exceed the minimum seller score threshold; e.g. a seller is considered to be recommended in comparison to other sellers who do not have scores high enough to be considered recommended sellers);

“and a detection module to detect outlying behavior by the first seller based on the comparison” (¶ 42 discloses determining whether the seller should be designated as a recommended seller, where recommended sellers are outliers).

Claims 11, 21, and 22 recite equivalent limitations to claim 1 and are, therefore, rejected using the same art and rationale as set forth above.

Furthermore, although Examiner has applied art to all limitations recited in the claims, Examiner considers the specific type of information to be nonfunctional descriptive material. The specific type of information used in the claimed invention does not change the structure of the system as claimed, nor does it change the method steps as they are claimed. Examiner asserts that the system and method of Harding is fully capable of handling any type of information.

In addition, in the system claim, there is no positive recitation for collecting, computing, comparing, or detecting. The system of the prior art is only required to be capable of performing those functions.

As per claim 2, Harding discloses “the first plurality of sellers includes sellers that have listed an item for sale, via the network-based marketplace, in a first category of items” (Fig. 4 shows a seller that has listed an item for sale in the electronics category).

Claim 12 recites equivalent limitations to claim 2 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 3, Harding discloses “the attribute information includes at least one of information to open a listing, information to close a listing and feedback information” (¶ 25 discloses feedback information volunteered by buyers).

Claim 13 recites equivalent limitations to claim 3 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 5, Harding discloses “attribute information includes a plurality of attributes” (¶ 25 lists the various seller attribute information that is collected by the system).

Claim 15 recites equivalent limitations to claim 5 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 8, Harding discloses “the second plurality of sellers is a high value peer group, and the comparison to module is to classify first seller is classified as high value seller” (¶ 46 discloses designating sellers as featured sellers).



Claim 18 recites equivalent limitations to claim 8 and is, therefore, rejected using the same art and rationale as set forth above.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**12. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding in view of Cheng et al. (2002/0059130, hereinafter Cheng).**

As per claim 4, Harding discloses all of the elements of the claimed invention but fails to explicitly disclose "the detection module is to automatically detect at least one of a fraudulent activity and a customer segmentation".

Cheng discloses a method and apparatus to detect fraudulent activities within a network based auction facility (abstract).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the profiling of sellers in a multiple seller marketplace of Harding to include the detection of fraudulent activities as taught by Cheng in order to deter sellers from conducting suspicious transactions in an auction environment.

Claim 14 recites equivalent limitations to claim 4 and is, therefore, rejected using the same art and rationale as set forth above.

**13. Claims 6, 7, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding.**

As per claim 6, Harding discloses computing peer information using statistics (¶ 26 discloses determining seller statistics).

Harding, however, fails to explicitly disclose “computing the peer information as a standard deviation and a mean”.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the profiling of sellers in a multiple seller marketplace of Harding to include the computing peer information as a standard deviation and mean because it is old and well known to use standard deviation and mean to conduct statistical analysis.

Claim 16 recites equivalent limitations to claim 6 and is, therefore, rejected using the same art and rationale as set forth above.

As per claim 7, Harding discloses classifying sellers as recommended sellers (¶ 42).

Harding, however, fails to explicitly disclose “the second plurality of sellers is an average seller peer group, and the comparison module is to classify the first seller as an average seller”.

It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the profiling of sellers in a multiple seller marketplace

of Harding to include the classification of sellers as average sellers in order to distinguish average sellers from recommended sellers or below average sellers.

Claim 17 recites equivalent limitations to claim 7 and is, therefore, rejected using the same art and rationale as set forth above.

**14. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harding in view of Amazon.com (2000).**

As per claim 9, Harding discloses all of the elements of the claimed invention but fails to explicitly disclose “the second plurality of sellers is associated with a first country, and the comparison module is to associate the first seller with the first country”.

Amazon discloses an online auction having international sites for different countries (pg. 2 via Our International Sites, where the international sites associate international sellers with a particular country).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the profiling of sellers in a multiple seller marketplace of Harding to include the association of sellers with particular countries as taught by Amazon.com in order to facilitate the use of the system by sellers from different countries.

Claim 19 recites equivalent limitations to claim 9 and is, therefore, rejected using the same art and rationale as set forth above.

***Response to Arguments***

15. Applicant's arguments filed April 2, 2009 have been fully considered but they are not persuasive.

In response to arguments that the cited references do not disclose "peer information computed by combining together the attribute information of a plurality of sellers" as required by the amended claims 1, 11, 21, and 22, Examiner, respectfully disagrees. In ¶ 42 of the Harding reference, it states that the facility uses a seller score threshold of 80. The threshold value represents those sellers that have a seller score greater than or equal to 80. The seller score itself represents attribute information or peer information. The threshold score of 80 is attribute information that is calculated for a plurality of sellers.

In response to arguments in reference to claims 2-9 and 12-19, all rejections made towards the dependent claims are maintained due to a lack of reply by the applicant in regards to distinctly and specifically pointing out the supposed errors in the examiner's prior office action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and patentable over the prior art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is (571) 270-5105. The examiner can normally be reached on Monday thru Thursday 7:30am- 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D. C./  
Examiner, Art Unit 3629

/JOHN G. WEISS/  
Supervisory Patent Examiner, Art Unit 3629